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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,317	05/15/2001	Dhiren K. Marjadi	AEI-177-A	1121

7590 05/18/2007  
Andrew R. Basile  
Young & Basile, P.C.  
3001 West Big Beaver Road, Suite 624  
Troy, MI 48084

EXAMINER
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AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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05/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/855,317	<b>Applicant(s)</b> MARJADI ET AL.	
	<b>Examiner</b> Evans Augustin	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This is in response to the remarks filed on 28 February 2007. Claims 1-12 are pending.

### ***Response to Arguments***

2. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on 28 February 2007, but has not found those arguments to be persuasive.

**Argument 1:** The combination of Christiano and Wyman fails to teach or suggest the ability of a single user request execution of a piece of digital content from one of the customer computer network or an application service provider (ASP).

**Response 1:** According to Wyman, programs are being executed on delegated servers (ASP) and user computer and units delegated to server and user computer (C 8, L 35-45). Units are deducted from an available pool when a user node makes a valid request (column 6, lines 48-49) - In a delegatee server 13, the units field 41 will have some subset of the units field in the original product use authorization. As units are granted to users 16 or delegated to server, the remaining units available for grant are indicated in a subfield 42 in the copy of the document used by the server (column 11, lines 17-22) - Paying/charging for check out units (C 14, L 40-41). Wyman teaches a plurality of user computers communicating with a host computer, where programs can be ran on either the host computer or the user computer, and predetermined units are being managed accordingly (C 8, L 60-63). The delegated servers are include CPUs in departments or divisions that users communicate to (C 8, L 28-29).

Application stands finally rejected.

### *Claim Interpretation*

3. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.
4. It should also be noted that, in the office action that:
  - A. Items in the rejection that are in quotation marks are claimed language/limitations
  - B. Functional recitation(s) using the word “for” or other functional terms have been considered but given less patentable weight<sup>1</sup> because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).
  - C. Word(s) that are separated by “/” are being examined as being synonymous or equivalent

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<sup>1</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

- D. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.
- E. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.
- F. Since the term “application service provider” is not lexicographically defined, the USPTO interprets in accordance to online dictionary of computer and internet terminology (<http://www.webopedia.com/>). Accordingly, A Hosting Services Provider (HSP) is an application service provider dedicated to providing hosting services. Therefore, an ASP is a server hosting applications for end users.
- G. According to Computer Dictionary, 3<sup>rd</sup> Edition, Microsoft Press, Redmond, WA, 1997<sup>2</sup>, a server is n. 1. On a local area network (LAN), a computer running

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<sup>2</sup> Based upon Applicants’ disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit

administrative software that controls access to the network and its resources, such as printers and disk drives, and provides resources to computers functioning as workstations on the network. 2. On the Internet or other network, a computer or program that responds to commands from a client. For example, a file server may contain an archive of data or program files; when a client submits a request for a file, the server transfers a copy of the file to the client.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christiano (U.S. 5,671,412), in view of Wyman (U.S. 5,745,879).
7. As per claims 1-12, Christiano discloses a license management system for software applications. The system can do the following:
- A. Provide licensed units to users (column (C) 3, line (L) 46) ("providing licensed units to a customer").

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used the *Microsoft Press Computer Dictionary* (3d ed.) as "a technical dictionary" to define the term "flag." See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971) (noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled 'New Terminology.'

- B. Client request for a component license for a component product in a package (C 4, L 15-17) – Client requesting for a designated/selected software product (C 4, L 35-36) ("providing independently selectable digital content ").
  - C. Assign a minimum/predetermined amount of units that a particular digital content requires to be used (C 17, L 36-38) ("assigning a predetermined number of customer computer network assigned units to each independently selected digital content when the digital content is run on the customer computer network").
  - D. Assign check out units based on the number of units being used by requester (column 19, line 67, column 20, lines 1-2)
  - E. A license is granted when the requested units **plus** the checked out units are less than or equal to the total licensed units (column 29, lines 4-9, column 20 lines 1-3). A license is denied if the logic is false (figure 9, item 174).
  - F. Each software program requires a minimum amount of units, in order for that particular program to be checked out (column 29, lines 20-24). The requested units for a particular program have to be greater than or equal to the minimum amount of units for that particular application (column 19, lines 40-45)
  - G. When the requested amounts of units are being used, the available total licensed units are reduced by the requested units (column 29, lines 35-38). Therefore, the units are charged against the total available units during execution of the requested software.
8. However, Christiano did not explicitly describe a system in which the licensed units can be distributed between a server and the user computer/network. The USPTO is introducing the aspect of Application Service Provider (ASP), as a server hosting applications for end users.

Accordingly Wyman teaches an invention that relates to methods of operation of computer systems, and more particularly to a method and system for managing the licensing of software executed on computer systems. According to Wyman the invention includes:

- A. Units granted in the product use authorization may be delegated to another server (column 7, lines 11-12)
- B. Units are deducted from an available pool when a user node makes a valid request (column 6, lines 48-49) - In a delegatee server 13, the units field 41 will have some subset of the units field in the original product use authorization. As units are granted to users 16 or delegated to server, the remaining units available for grant are indicated in a subfield 42 in the copy of the document used by the server (column 11, lines 17-22) - Paying/charging for check out units (C 14, L 40-41) ("charging a number of checked out units to the customer computer network based on the digital content currently being run by the customer on the customer computer network and on the application service provider").
- C. Programs being executed on delegated servers (ASP) and user computer and units delegated to server and user computer (C 8, L 35-45) ("selecting through the customer computer network one of the customer computer network and the application service provider for execution of a selected digital content").
- D. The invention determines whether or not the available units is zero or too small to permit the requested use (column 35-37) ("determining a number



of available units equal to the difference between the total licensed units to the customer computer network and the total checked out units charged to the customer computer network for digital content currently being executed on the customer computer network and on the application service provider for the customer")

- E. If determination is false, the user can make the proper provision or the application can itself be structured to shut itself down if not authorized to run, or it can be structured to shut down certain functions (e.g., ability to save files, ability to print, etc.) (column 12, lines 55-57) ("determining whether a requested digital content is to be executed or denied execution on the selected one of the customer computer network and the application service provider based on the difference between the available units on the customer computer network requesting execution of the digital content and the assigned units of the selected digital content on the selected customer computer network and the application service provider")
- F. Number of units available for future use declines upon every use of the licensed software product (column 14, lines 29-30)

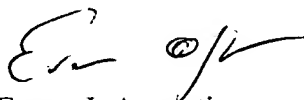
9. Therefore, it would have been obvious for one skilled in the art of digital content distribution and delivery over an open network to combine Christiano's invention, which deals with a license management system for software applications, with Wyman's invention concerning methods of operation of computer systems, and more particularly to a method and system for

managing the licensing of software executed on computer systems. It would have been obvious because (motivation) according to Wyman, the delegation of units allows an administrator to distribute units to improve response time and increase the resilience of the system (column 11, lines 46-48), and may be used as a method of allocating licensed units within a budget for administrative purposes (column 11, lines 54-55).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.



Evens J. Augustin

May 14, 2007

Art Unit 3621



ANDREW J. FISCHER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600